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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,215	12/18/2000	Eugene H. Carlson	55313USA6A.002	4346

7590 06/19/2002

Attention: Rudolph P. Hofmann, Jr.
Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, MN 55133-3427

EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 06/19/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

MFE

Office Action SummaryApplication No.
09/740,215Applicant(s)
Carlson et al.Examiner
Nasser AhmadArt Unit
1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above, claim(s) 31-47, 53, 54, and 65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30, 48-52, and 55-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2, 3, 4
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-30, 48-52 and 55-64, drawn to a retro reflective article, classified in class 428, subclass 40.1.
 - II. Claims 31-41, drawn to a method of making a retro reflective article, classified in class 156, subclass 265.
 - III. Claims 42-47, 53-54 and 65, drawn to a method of applying a retro reflective article, classified in class 156, subclass 290.
2. The inventions are distinct, each from the other because:
3. Inventions group II and group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as laminating the strip and the carrier, then cutting the strip by removing unwanted portions to form discrete segments.
4. Inventions group I and group III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as using it as a marker or decorative article, instead of combining it with other substrate.

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Invention groups II and III are distinct and independent, and capable of supporting separate applications.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Mr. Rudolph P. Hoffman, Jr. on May 2, 2002 a provisional election was made without traverse to prosecute the invention of group I, claims 1-30, 48-52 and 55-64. Affirmation of this election must be made by applicant in replying to this Office action. Claims 31-47, 53-54 and 65 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, 9-14, 22-28, 48-52 and 55-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Bacon (5,632,946).

Bacon relates to a retro reflective article comprising an elongate carrier and a plurality of comprising an elongate carrier and a plurality of discrete segments of retro reflective sheeting disposed on the carrier. The shape of the segments are repeated along the elongate carrier (abstract and col. 2, lines 59-60). The carrier is adhesively adhered to the viewing surface of the sheeting (col. 7, lines 52-58). The segments form pattern, signs, etc. and can be attached to vehicles, garments, etc. (col. 1, lines 12-19). The carrier is extensible (col. 3, lines 1-4) and the

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substrate is curved. The sheeting is prisinatic or encapsulated retro reflective sheeting with sealed edges. The segments are shown to be identical. The discrete segments provide for gap between segments of less than one millimeter, which would inherently inhibit wrinkling when bent around a selected radius. The segments are spaced apart (col. 3, lines 8-19 and 45-47).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-18, 21-28, 48-52 and 55-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacon in view of Vesely (3,936,567).

Bacon, as discussed above, fails to teach that the adhesive is provided with a release surface. Vesely relates to a retro reflective adhesive label provided with a release liner to protect the adhesive surface. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Vesely's teaching of providing protective release surface for the adhesive in the invention of Bacon wherein the adhesive is provided on the nonviewing surface.

The adhesive strength of the differently adhesive would be obvious to vary depending on the desired utility such as for transfer application, the adhesive on the nonviewing face would have higher strength.

It would have been an obvious matter of design choice to modify Bacon by providing 25-75 mm segments with gaps of at most 40% of segment length, as such as a modification would have involved a mere change in the size of the segments. The gaps can be taken as non-retro reflective segments.

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11. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over bacon in view of Schultz (4,085,314).

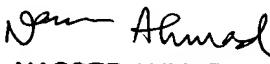
Bacon, as discussed above, fails to teach that the carrier includes slits or holes. Schultz relates to a retro reflective sheeting including a cover sheet cut to form removable sections (abstract). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Schultz's teaching of using slit containing cover carrier layer in the invention of Bacon to provide for removability and enhanced flexibility.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 703 308-4424. The examiner can normally be reached on Monday-Thursday and on alternate Fridays from 7:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and 703 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-0661.

Examiner Ahmad/ng
June 13, 2002


NASSER AHMAD
PRIMARY EXAMINER